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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,586	03/08/2001	Shigeru Ohuchida	R2180.0104/P0104	1448

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DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
2101 L STREET NW
WASHINGTON, DC 20037-1526

EXAMINER

BATTAGLIA, MICHAEL V

ART UNIT

PAPER NUMBER

2652

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/800,586	Applicant(s) OHUCHIDA ET AL.	
	Examiner Michael V Battaglia	Art Unit 2652	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached Response to Arguments.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 23 and 25.

Claim(s) objected to: _____.

Claim(s) rejected: 1-5, 7-22 and 24.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Allowable Subject Matter

1. Claims 23 and 25 are allowable over the prior art of record.

Response to Arguments

2. Applicant's arguments filed August 6, 2004, with respect to rejections using Takeda (US 6,084,844) have been fully considered but they are not persuasive.

In regard to claims 1, 10 and 24, Takeda discloses a diffracting device configured to transmit the light beam emitted from the light source, and to diffract a light beam reflected from the optical recording medium (Figs. 1A, 1B, and 3C; elements 33-34) and an optical device having a reflecting portion and a transmitting portion, configured to reflect one part of the light beam emitted from the light source to the diffracting device by the reflecting portion and to transmit another part of the light beam emitted from the light source to the optical recording medium by the transmitting portion, and to transmit the light beam reflected from the optical recording medium to the diffracting device by the transmitting portion (Figs. 1A, 1B, and 3C; elements 31 and 35); wherein the diffracting device includes a diffracting portion to diffract the one part of the light beam reflected by the reflecting portion of the optical device to the photodetecting device for monitor light detection of the light source (Fig. 3C, element 34 and Figs. 1A and 2B, element 8).

It is noted that the advantages of the claimed invention over the structure of Takeda are not recited in the rejected claim(s). Examiner disagrees with Applicant's statement of the difference between a transmissive hologram and a reflection hologram. Examiner interprets a transmissive hologram as a hologram that transmits light. The diffraction grating of the hologram of Takeda shown in sections 33 and 34 of Fig. 3C transmit light to the optical recording medium and to the reflecting portion (Fig. 3C, element 35) of the optical device, respectively and therefore, the Takeda

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discloses a transmissive hologram. It is further noted that the Figs. 3B and 3C provide alternate embodiments for the hologram lens (Fig. 1, element 3). Examiner only cites Fig. 3C as using a transmissive hologram.

The arguments regarding claims 2-4, 9, 20 and 22 depend only on the allowability of rejected claim 1 are moot for the reasons stated above.

In regard to claim 4, the diffracting device is interpreted as a polarization hologram because a polarizing property is given to the diffraction device to efficiently transmit/diffract laser light to/from the optical recording medium (Col. 7, lines 42-45). A portion of the polarization hologram, i.e. a polarization hologram portion, is configured to diffract the light beam reflected by the optical device to the photodetecting device for monitor light detection (Col. 6, lines 16-19). It is noted that the second diffraction area having conventionally configured grooves and ridges cannot efficiently reflect and diffract laser light toward the optical detector for monitoring while the second diffraction area of Takeda can (Col. 7, lines 40-60). The bright-dark type diffraction grating is the diffraction grating in the second diffraction area (Fig. 3B, element 34) of Fig. 3B. Fig. 3C provides an alternate embodiment for the hologram lens of Fig. 3B (Col. 6, lines 9-19) in which light incident on the second diffraction area is reflected and diffracted using a reflecting portion and a transmissive hologram (Fig. 3C). The features of the present invention discussed on page 20, line 18-page 21, line 16 are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In regard to claim 9, Fig. 3B is not used in the rejection of claim 9. Fig. 3C shows the reflecting portion (Fig. 3C, element 35) of the optical device extends into the diffracting device (Fig. 3C, elements 331 and 341) so that the diffracting device abuts the optical device in more than

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one plane. As a result, a section of the diffracting device at a side of the optical device forms a section of bilateral asymmetry. Furthermore, there is no limit on the shape of the section of the diffracting device and therefore, a section of the diffracting body having a bilaterally asymmetric shape at the side of the optical device is bilaterally asymmetric.

3. Applicant's arguments filed August 6, 2004, with respect to the rejections of claims 12, 14, 16 and 17 under 35 U.S.C. 102(b) as being anticipated by Kay et al (hereafter Kay) (US 5,544,143) have been fully considered but they are not persuasive. See rejections stated in the Final Action dated April 27, 2004.

4. Applicant's arguments filed August 6, 2004, with respect to the rejections of claims 5, 7, 8, 11, 13, 15, 18 and 19 under 35 U.S.C. 103(a) as being anticipated by Kay in view of Ohyama (US 6,512,608) have been fully considered but they are not persuasive.

In regard to the limitations suggested by Kay, see the rejections stated in the Final Action dated April 27, 2004.

In response to applicant's argument that there is no suggestion or motivation in Kay to combine the references, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in **either** reference or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is provided by Ohyama as stated in the previous Office action.

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Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V Battaglia whose telephone number is (703) 305-4534. The examiner can normally be reached on 5-4/9 Plan with 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael V. Battaglia



W. R. YOUNG
PRIMARY EXAMINER